

Appl. No. : 09/988,850
Filed : November 19, 2001

REMARKS

Claims 7, 19 and 20 have been amended by this paper while Claims 8-18 and 21-28 remain unchanged. Hence, by this paper, Claims 7-28 are presented for further examination.

The specific changes to the specification and the amended claims are shown in the above section entitled IN THE CLAIMS. On this set of pages, the insertions are underlined while the ~~deletions are stricken through~~.

In the Office Action mailed July 30, 2004, Claim 19 was rejected under 35 U.S.C. § 112, & 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Examiner stated that “the term ‘semi-reflective’ in Claim 19 is a relative term which renders the claim indefinite.” The Examiner went on to say that “it is unclear how much reflectivity would render the information layer to be considered semi-reflective as opposed to reflective or unreflective.”

In response to this rejection, Applicant has amended Claim 19 to replace the term “semi-reflective” with “partially transmissive and partially reflective.” Support for this amendment is found at least on page 36, lines 3-4, of the application. Applicant submits that one skilled in the art will readily recognize whether a surface is reflective, transmissive or is partially transmissive and partially reflective. Generally, when a light beam impinges upon a surface, if part of that beam is reflected from the surface while a portion travels into or through the surface, that surface would be partially reflective and partially transmissive. It would be unreasonable to describe whether a surface is reflective or partially reflective, for example, by trying to define some threshold percentage of light reflected as being a boundary between reflective and partially reflective. These terms are known and understood in the industry and, accordingly, Applicant submits that Claim 19, as amended, is sufficiently definite to overcome the rejection under 35 U.S.C. § 112, & 2. Accordingly, Applicant respectfully requests that this rejection of Claim 19 be withdrawn.

In the Office Action, Claim 20 was rejected under 35 U.S.C. § 102(b) as being anticipated by Coleman (U.S. Patent No. 3,799,742).

As defined in independent Claims 7 and 20, one embodiment of Applicant’s invention is directed to an “optical-bio disc for performing a blood-typing assay, said disc configured to be rotated ...” (emphasis added). Further, the optical-bio disc and chambers included thereon “are configured such that fluid is transmitted from at least one of the chambers to another of the

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chambers that is in fluid communication therewith in response to rotation of the disc." (emphasis added)

In contrast, Coleman discloses an analytical test container which is used for conducting analytical tests. There is no teaching or suggestion in Coleman of a test container which is configured as a disc or which is configured to be rotated. Certainly, the arrangement of chambers disclosed in Coleman does not define a configuration such that fluid "is transmitted from at least one of the chambers to another of the chambers that is in fluid communication therewith in response to rotation of" a disc.

Accordingly, Applicant respectfully submits that Coleman neither teaches nor suggests subject matter as defined in Applicant's Claim 20. Thus, Applicant submits that Claim 20 defines subject matter which is patentable over Coleman. Furthermore, it appears that the Examiner also intended to reject Claims 21-26 under 35 U.S.C. § 102(b), based upon the Examiner's comments in the pending Office Action. However, since Claims 21-26 each depend from independent Claim 20, Applicant respectfully submits that these dependent claims also define subject matter which is patentable over Coleman for the reasons set forth above.

In the Office Action mailed July 30, 2004, the Examiner rejected Claims 7-13 and 23-26 under 35 U.S.C. § 103(a) as being unpatentable over Coleman (U.S. Patent No. 3,799,742) in view of Sheppard, Jr. et al. (U.S. Patent No. 6,319,468, hereinafter "Sheppard"). In addition, the Examiner rejected Claims 14-15 and 27-28 under 35 U.S.C. § 103(a) as being unpatentable over Coleman and Sheppard, as applied to Claims 7 and 20 (above), and further in view of Chow (U.S. Patent No. 6,167,910).

Applicant notes that Claim 7, as presented herein, includes those features described above with reference to Claim 20. Accordingly, Applicant's arguments regarding the differences between the elements of Claim 20 and Coleman apply equally to the differences between Claim 7 and Coleman.

Applicant notes that Sheppard does not disclose or suggest the structure defined in Applicant's Claim 7, as presented herein. Since Coleman also does not teach or suggest such structure, Applicant respectfully submits that the combination of Coleman and Sheppard do not teach or suggest the subject matter set forth in independent Claim 7 nor do they teach or suggest the subject matter of independent Claim 20, as these claims are presented herein. For example, as discussed above with respect to Coleman, these references do not, taken individually or in

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combination, teach or suggest "an optical-bio disc for performing a blood-typing assay, said disc configured to be rotated" and the combination of the disc with chambers being "configured such that fluid is transmitted from at least one of the chambers to another of the chambers that is in fluid communication therewith in response to rotation of the disc." (*See, e.g.*, Claims 7 and 20).

In view of the above, Applicant respectfully submits that Claim 7, as well as independent Claim 20, defines subject matter which is patentable over Coleman and Sheppard, taken individually or in combination. Furthermore, since each of Claims 8-19 and 21-28 depend from one of Claims 7 or 20, it is submitted that these dependent claims also define subject matter which is patentable over Coleman and Sheppard, for the reasons set forth above. Furthermore, since Claims 14-15 and 27-28 also each depend from one of independent Claims 7 and 20, Applicant submits that these dependent claims also define patentable subject matter over the combination of Coleman, Sheppard and Chow. Accordingly, Applicant respectfully requests that the rejections under 35 U.S.C. § 103(a) be withdrawn.

In the Office Action mailed July 30, 2004, the Examiner requested that the Applicant "show why the prior art structures were not capable of performing the intended uses recited in the instant claims, or demonstrate why the prior art structures would be different from the structures recited in the instant claims . . .". This comment was made in reference to Applicant's arguments in the Amendment mailed March 22, 2004. In response, Applicant respectfully draws the Examiner's attention to the second and third paragraphs on page 12 of the above-identified response. The arguments presented therein indicate why the prior art structures were different from the structures recited in the instant claims.

In view of the foregoing, Applicant respectfully submits that Claims 7-28, as presented herein, define subject matter that is patentable over the art of record. Accordingly, Applicant respectfully submits that Claims 7-28 are now in condition for immediate allowance and such prompt allowance of the same is respectfully requested.

CONCLUSION

The Applicant has endeavored to address all of the concerns of the Examiner in view of the recent Office Action directed to the above-identified application. Accordingly, amendments to the claims, the reasons therefor and arguments in support of the patentability of the pending claims are presented above.

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Any claim amendments which are not specifically discussed in the above remarks are not made for patentability purposes, and it is believed that the claims would satisfy the statutory requirements for patentability without the entry of such amendments. Rather, these amendments have only been made to increase claim readability, to improve grammar, and to reduce the time and effort required of those in the art to clearly understand the scope of the claim language. Any new claims presented above are of course intended to avoid the prior art, but are not intended as replacements or substitutes for any cancelled claims. They are simply additional specific statements of inventive concepts described in the application as originally filed.

In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections is specifically requested. If the Examiner finds any remaining impediment to the prompt allowance of these claims that could be clarified with a telephone conference, the Examiner is respectfully requested to initiate the same with the undersigned.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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